



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,671	05/26/2000	Anthony A. Shah-Nazaroff	042390.P6484D1	9195

7590 04/28/2004

Gordon R Lindeen III
Blakely Sokoloff Taylor & Zafman LLP
7th Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025

EXAMINER

BUI, KIEU OANH T

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,671

Applicant(s)

SHAH-NAZAROFF ET AL.

Examiner

KIEU-OANH T BUI

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on 02/12/2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks et al. (U.S. Patent No. 6,539,548 B1/ or "Hendricks" hereinafter).

Regarding claim 1, Knee discloses "a method comprising: receiving information regarding a plurality of different entertainment programs and a plurality of different upgraded media features associated with each entertainment program" (Figs. 14-16 shows menus of available programs and different upgraded media features associated with each program, i.e., special interest channels has 16 selections, promos, data stream within available menu 244

Art Unit: 2611

received from sources as illustrated in Figures 2 & 3); “displaying at a user terminal a list of entertainment programs and, for each entertainment program, a plurality of different upgraded media features” (as shown in Figs. 25a, 25b, 25c, 25d, programs are displaying to the user in “basis”, “basic plus”, “economy” and “Ala Carte and Premium” as well as choices for “High Definition Services” as upgraded features for regular programs); “transmitting an entertainment program selection together with one or more upgraded media feature selections from the displayed plurality to an entertainment program provider; receiving the selected entertainment program with the selected upgraded media features”, i.e., the user selects their choice and the service provider receives the request and provides the service to the user (Fig. 27b for “Hit Movies” at the user’s command, Figs. 27c-27f for channels selected from different programs, and Fig. 31b as HDTV services are provided per the user’s request, see more at col. 36/line 19 to col. 37/line 19, and col. 38/line 43 to col. 39/line 8).

As for claim 2, in further view of claim 1, Hendricks further discloses “wherein receiving information comprises receiving information regarding costs for each of the plurality of different upgraded media features and wherein displaying comprises displaying the costs” (Figs. 27c to 27g, Fig. 31b for HBO HDTV, and Fig. 33c for interactive digital services with the cost, see more at col. 36/line 58 to col. 37/line 8 & col. 38/lines 44-60).

As for claims 3 and 4, in further view of claim 1, Hendricks further discloses “comprising: receiving an entertainment selection and an upgraded media feature selection from a user through the user terminal; and wherein transmitting the selections comprises transmitting the selections received from the user” and “wherein the user selection is received by interpreting signals transmitted from a user infrared transmitter”, i.e. the user uses a conventional remote

Art Unit: 2611

900—inherently understood using infrared signals—for selecting programs and menus from the headend via cable set top box 220 at the user terminal 222 (as shown in Fig. 3, and col. 12/line 55 to col. 13/line 14 for a user remote controller).

As for claim 5, in further view of claim 1, Hendricks further suggests “wherein the plurality of different upgraded media features comprises at least one of video resolution upgrades, audio quality upgrades, audio channel upgrades, a recordable version, and an increased access rate for an interactive event”, i.e., at least video resolution upgrades or audio channel upgrades or CD recordable for storage are addressed (Fig. 31b for HDTV services; Fig. 33c for interactive digital service upgrade for local storage, see col. 41/lines 8-14; and Figs. 35a-35e for digital music audio quality and channel upgrades).

As for claim 6, in further view of claim 1, Hendricks further discloses “wherein receiving information comprises receiving information regarding available programming transmission sources for the plurality of different upgraded media features and wherein displaying comprises displaying an identification of the programming transmission sources” (Fig. 31b for HBO, ShowTime are identification of sources for HDTV; and Fig. 35 for the source of digital music from a performer Rachmaninoff).

As for claim 7, in further view of claim 6, Hendricks further discloses “wherein the programming transmission sources comprise at least one of local television stations, local radio stations, satellite broadcasters, coaxial cable broadcasters, and interactive sites on the internet” (Fig. 1, and col. 6/line 25 to col. 7/line 7 for cable coaxial, optics, satellite, local broadcast stations; and col. 41/line 15 to col. 43/line 58 for interactive services including the Internet and local radio stations).

As for claim 8, in further view of claim 7, Hendricks further discloses “wherein the programming transmission sources further comprise at least one of video tape, video disk and audio disk” (col. 28/lines 10-29).

As for claim 9, in further view of claim 1, Hendricks further discloses “wherein receiving information comprises receiving information from a server system that is in communication with a plurality of programming transmission sources and wherein transmitting the selections comprises transmitting the selections to the server system” (col. 27/lines 20-40 for a server system within an operation center for delivering television and interactive services).

As for claim 10, in further view of claim 9, Hendricks suggests “wherein receiving the selected entertainment program comprises receiving the selected entertainment program with the selected upgraded media features from one of the plurality of programming transmission sources” (Fig. 14 shows a plurality of available programming transmission sources).

As for claim 11, in further view of claim 10, Hendricks further discloses “wherein the upgraded media feature comprises at least one of a video upgrade, an audio upgrade, a recordable version, and an increased access rate for an interactive event”, i.e., at least video resolution upgrades or audio channel upgrades or CD recordable for storage are addressed (Fig. 31b for HDTV services; Fig. 33c for interactive digital service upgrade for local storage, see col. 41/lines 8-14; and Figs. 35a-35e for digital music audio quality and channel upgrades).

As for claim 12, in further view of claim 1, Hendricks further discloses “wherein receiving the selected entertainment program comprises receiving the selected entertainment program from one of a plurality of programming transmission sources and the plurality of programming transmission sources include at least one of cable television, antenna reception, satellite

Art Unit: 2611

reception, mini-dish satellite reception, telephone dial-up service, and Internet access” (Fig. 1, and col. 6/line 25 to col. 7/line 7 for cable coaxial, optics, satellite, local broadcast stations; and col. 41/line 15 to col. 43/line 58 for interactive services including the Internet and local radio stations).

As for claim 13, in further view of claim 1, Hendricks suggests “wherein receiving the selected entertainment program comprises receiving a token from an appropriate one of a plurality of programming transmission sources, the token enabling the reception of the selected entertainment program with the upgraded media feature”, i.e., a code is used as a token for identifying and enabling the reception of a selected program with the upgraded media feature (Figs. 6a & 6b for data format for a control program information signal, see more at col. 21/line 37 to col. 22/line 3).

Regarding claims 14-23, these claims for “a machine readable medium having stored thereon data representing sequences of instructions which when executed by a processor, cause the processor to: receive information regarding a plurality of different entertainment programs and a plurality of different upgraded media features associated with each entertainment program; display at a user terminal a list of entertainment programs and, for each entertainment program, the plurality of different upgraded media features; transmit an entertainment program selection together with one or more upgraded media feature selections from the displayed plurality to an entertainment program provider; receive the selected entertainment program with the selected upgraded media features” are rejected for the reasons given in the scope of claims 1-13 as disclosed in details above.

Regarding claims 24-37, these claims for “a method comprising: transmitting information regarding a plurality of different entertainment programs and a plurality of different upgraded media features associated with each entertainment program to a plurality of client systems; receiving an entertainment program selection together with one or more upgraded media feature selections from at least one of the plurality of client systems; providing the client system with access to receive the selected entertainment program with the selected upgraded media features” and “a machine readable medium having stored thereon data representing sequences of instructions which when executed by a processor, cause the processor to: transmit information regarding a plurality of different entertainment programs and a plurality of different upgraded media features associated with each entertainment program to a plurality of client systems; receive an entertainment program selection together with one or more upgraded media feature selections from at least one of the plurality of client systems; provide the client system with access to receive the selected entertainment program with the selected upgraded media features” with same limitations are rejected for the reasons given in the scope of claims 1-13 as disclosed in details above.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Knee et al (US Patent 5,589,892), Maa (US Patent 5,818,935), Howe et al. (US Patent 5,892,508), and White et al. (US Patent 6,392,664 B1) discloses program guide systems with interactive services.

Art Unit: 2611

5. **Any response to this action should be mailed to:**
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park IV, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Krista Bui
Art Unit 2611
April 21, 2004


KRISTA BUI
PATENT EXAMINER